

Reply under 37 C.F.R. 1.116
Expedited Procedure
Examining Group 2169
Patent
Application 10/577,823
Attorney Docket 1041-006

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

The specification has been amended to correct a matter of form and one or more typographical errors. It is respectfully submitted that no new matter has been introduced.

Each of claims 1, 23, 36, and 37 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Each of claims 46-48 has been added.

Claims 1-48 are now pending in this application. Each of claims 1, 23, and 36 is in independent form.

I. Claim Construction

Before *prima facie* criteria for a substantive rejection can be applied, the words of each claim must be interpreted. The Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), *cert. denied*, 546 U.S. 1170, 126 S.Ct. 1332, 164 L.Ed.2d 49 (2006) has clarified that:

1. "[t]he Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art'" (*Id.* at 1316);
2. the words of a claim "are generally given their ordinary and customary meaning" (*Id.*

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at 1312);

3. the ordinary and customary meaning of a claim term is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application” (*Id.* at 1313);
4. “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent**, including the specification” (*Id.*);
5. even “the context in which a term is used in the asserted claim can be highly instructive” (*Id.* at 1314);
6. “the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor’s lexicography governs**” (*Id.* at 1316);
7. even “when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents” (*Id.* at 1321);
8. an “invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office” (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
9. the “prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited during the examination of the patent**” (*Id.* at 1317).

The rules established in *Phillips* apply to *ex parte* examination in the USPTO. *See, In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005).

II. The Indefiniteness Rejections

Claim 43 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite, and thus was asserted to be unpatentable. This rejection is respectfully traversed.

Regarding indefiniteness rejections, the Federal Circuit has held that the law is clear that

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If the claims, read in light of the specification, reasonably apprise those skilled in the art of the use and scope of the invention, and if the language is as precise as the subject matter permits, the claims are definite under Section 112, second paragraph. *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 USPQ 634 (Fed. Cir. 1985), *cert. dismissed*, 474 U.S. 976 (1985).

The present Office Action fails to provide any evidence that claim 43 would not reasonably apprise those skilled in the art of the use and scope of the invention. Instead, the present Office Action merely asserts, at Page 5:

[r]egarding claim 43, Applicant recites '*Edition query*', '*Shell relationship*', '*Shell of Editions*' without any explicit/deliberate definitions for these terms.

Since these terms are not well-known in the art, they would leave the readers in doubt regarding their particular meanings of the claimed subject matters.

This assertion presents no evidence that one having ordinary skill in the art that claim 43, when "read in light of the specification," does not "reasonably apprise those skilled in the art of the use and scope of the invention." Absent evidence that the claimed subject matter would not reasonably apprise those skilled in the art of the use and scope of the invention, no *prima facie* rejection is established.

For at least this reason, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 43:

III. The Statutory Subject Matter Rejections

Each of claims 1-22 and 36-45 was rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter, and thus was asserted to be unpatentable. Each of these rejections is respectfully traversed.

A. Legal Standards

1. The Statute

The statute of 35 U.S.C. 101 states, "[w]hoever invents or discovers any new and useful

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process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title”.

2. Computer Software

The Federal Circuit has held (internal citations omitted), in *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999) (quoting *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998), cert. denied, U.S., 119 S. Ct. 851 (1999), that:

“[u]npatentable mathematical algorithms are identifiable by showing they are merely abstract ideas constituting disembodied concepts or truths that are not ‘useful’ ... [T]o be patentable an algorithm must be applied in a ‘useful’ way.” In that case [referring to *State Street*], the claimed data processing system for implementing a financial management structure satisfied the 101 inquiry because it constituted a “practical application of a mathematical algorithm ... [by] produc[ing] ‘a useful, concrete and tangible result.’”

The Federal Circuit further explained (regarding a standard established in *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994)) in *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999) (internal citations omitted) that:

the Alappat inquiry simply requires an examination of the contested claims to see if the claimed subject matter as a whole is a disembodied mathematical concept representing nothing more than a “law of nature” or an “abstract idea,” or if the mathematical concept has been reduced to some practical application rendering it “useful.” In *Alappat*, we held that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete, and tangible result of a smooth waveform display.

Applicant respectfully submits that the claimed subject matter in both *In re Alappat* and *State Street*, both of which were held to comprise statutory subject matter, were directed toward

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a machine that achieved certain results. See *AT&T v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999). Similarly, the claimed subject matter in *AT&T* was held to comprise statutory subject matter since the claimed subject matter resulted in differential billing for long-distance calls. *Id.*

Also of note is a BPAI decision applying the criteria of *State Street Bank* and relating to analogous subject matter to the present application. The claims at issue in this BPAI decision stated, *inter alia*, (emphasis added) "means for receiving from a supplier a candidate or candidates with appended resumes as appropriate; and means for **displaying for the user the supplier responses and associated resumes.**" *Ex parte Parks*, 2004 WL 4979154 (BPAI 2006). The BPAI found the claims of *Ex Parte Parks* statutory as "certainly useful in matching the skills wanted by a user with the skills of technicians employed by a supplier". The BPAI further commented, "[t]he invention produces a concrete result because a list, or choice, of candidates is provided to the user"

According to MPEP 2106 IV.B.1.a, "a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory."

This view is echoed by the Federal Circuit. An "invention includes 'any new and useful process, machine, manufacture or composition of matter.'" *Eolas Technologies Inc. v. Microsoft Corp.*, 399 F.3d 1325 (Fed. Cir. 2005) (citing 35 U.S.C. § 101 (2000)). "Without question, **software code alone qualifies as an invention eligible for patenting under these categories, at least as processes.**" *Id.* (citing *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999); MPEP § 2106.IV.B.1.a. (8th ed., rev. 2 2001)). "[S]oftware code claimed in conjunction with a physical structure, such as a disk, fits within at least those two categories of subject matter within the broad statutory label of 'patented invention.' *Id.*

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B. Analysis

The rejection of claim 1 is traversed as moot in view of the present amendments to claim 1. Specifically, claim 1, from which each of claims 2-22 and 37-45 ultimately depends, states, *inter alia*, "a machine readable medium storing instructions, executable by an information device", which is a "computer program". Thus, claim 1 complies with the standard of MPEP 2106 IV.B.1.a as a "computer program" that defines "interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized".

For at least these reasons, reconsideration and withdrawal of each of the rejections of claims 1-22 and 37-45 is respectfully requested.

Claim 36 also complies with the standard of MPEP 2106 IV.B.1.a. Claim 36 states, *inter alia*, a "computer-readable medium" encoded with a "instructions" that are "executable by an information device, which is a "computer program". The "computer program" defines "interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized".

Applicant notes that the present Office Action asserts, at Page 8:

[r]egarding claim 36, 'a machine readable medium' is being claimed. However, the Applicant did not explicitly provide any definition and/or example for this instant 'machine readable medium' in the disclosure. Consequently, the Examiner views this claimed 'machine readable medium' to include 'a transmission media' (Specification, Page 6, [41]), which typically embodies computer readable instructions, data structures, program modules or other data in modulated data signal such as carrier wave or other transport mechanism and includes any information delivery media. As such, the claims are drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim is not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical or object and as such is not a machine or

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manufacture. Energy is not a combination of substances and therefore not a composition of matter.

Applicant respectfully traverses this assertion as being contrary to law regarding claim construction requirements under *Phillips*. Specifically, no evidence is of record that one having ordinary skill in the art would interpret the claim phrase "machine readable medium", when read in view of the specification, to include a "transmission media". In addition, paragraph 41 of the application as originally submitted provided a definition for the claim term "network". No evidence is of record that one having ordinary skill in the art would interpret the phrase "machine-readable medium" to mean a "network". Further, no evidence is of record that one having ordinary skill in the art would interpret the phrase "machine readable medium storing instructions", when read in view of the specification, to mean or be the equivalent of a "transmission media". Thus, the assertions at page 8 are contrary to law and fail to establish a *prima facie* rejection of claim 36.

For at least these reasons, reconsideration and withdrawal of the rejection of claim 36 is also respectfully requested.

IV. The Anticipation Rejections

Each of claims 1-9, 12, 14-17, 19-20, 23-31, 33, 35, and 36 was rejected as anticipated, and thus unpatentable, under 35 U.S.C. 102(b). In support of the rejection, various portions of U.S. Patent Publication 20020107883 ("Schneid") were applied. These rejections are respectfully traversed as moot in view of the present amendments to each of independent claims 1, 23, and 36.

Specifically, each of independent claims 1, 23, and 36, from one of which each of claims 2-9, 12, 14-17, 19-20, 24-31, 33, and 35 ultimately depends, states, *inter alia*, yet no evidence is of record that the applied portions of Schneid teach, "automatically and individually" controlling "a content, a plurality of content attributes, a usage permission, and a distribution permission of each of a plurality of objects in each of multiple documents derived from the source document, the distribution permission comprising a non-commercial permission".

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V. The Obviousness Rejections

Each of claims 10, 11, 13, 18, 21, 22, 32, 34, and 37-45 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent - Publication 20020107883 ("Schneid"), U.S. Patent Publication 20040216033 ("Hallett"), U.S. Patent 5,491,760 ("Withgott"), U.S. Patent Publication 20020188841 ("Jones"), U.S. Patent 6,370,498 ("Flores"), and/or U.S. Patent 6,078,924 ("Ainsbury"). Each of these rejections is respectfully traversed as moot in view of the present amendments to each of independent claims 1, 23, and 36.

As indicated above, each of independent claims 1 and 23, from one of which each of claims 10, 11, 13, 18, 21, 22, 32, 34, and 37-45 ultimately depends, states, *inter alia*, yet no evidence is of record that the applied portions of Schneid or any other cited reference, alone or in combination, teach, "automatically and individually" controlling "a content, a plurality of content attributes, a usage permission, and a distribution permission of each of a plurality of objects in each of multiple documents derived from the source document, the distribution permission comprising a non-commercial permission".

In addition, claim 37 states, *inter alia*, yet no evidence is of record that the applied portions of Schneid or any other cited reference, alone or in combination, teach, "the computer-based document management module adapted to return all editions of the multiple documents having a same shell identifier number as a found document that comprises the user-selected topic".

VI. New Claims

1. Claim 46

Claim 46 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the usage permission comprises a by attribution security level, the by attribution security level adapted to build upon the source document without additional permissions so long as original credits remain in a new edition

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based upon the source document, the by attribution security level unchangeable by a user, the by attribution security level automatically copied to derivative versions of the source document, the by attribution security level not user changeable in the derivative versions of the source document". For at least this reason, a Notice of Allowance regarding claim 46 is respectfully requested.

2. Claim 47

Claim 47 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the non-public permission causes a disclaimer to be printed in a front and back cover of each copy of each edition comprising the non-public permission, the disclaimer stating that the edition has been created for private, non-public distribution". For at least this reason, a Notice of Allowance regarding claim 47 is respectfully requested.

3. Claim 48

Claim 48 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "wherein the noncommercial permission causes a disclaimer to be printed in a front and back cover of each copy of each edition comprising the non-public permission, the disclaimer stating that the edition has been created for noncommercial distribution". For at least this reason, a Notice of Allowance regarding claim 48 is respectfully requested.

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CONCLUSION

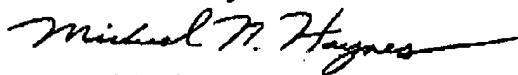
It is respectfully submitted that the application is in clear condition for allowance.

Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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